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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,852	11/06/2001	Koji Utsugi	Q67040	4392
75	90 05/14/2003			
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3202			EXAMINER	
			WEINER, LAURA S	
		,	ART UNIT	PAPER NUMBER
			1745	
*.			DATE MAILED: 05/14/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<u> </u>		· He-
	Application No.	Applicant(s)
•	09/985,852	UTSUGI ET AL.
Office Action Summary	Examin r	Art Unit
	Laura S Weiner	1745
The MAILING DATE of this communicate Period for Reply	tion app ars on the cover shet w	vith the correspond nce address
A SHORTENED STATUTORY PERIOD FOR THE MAILING DATE OF THIS COMMUNICA Extensions of time may be available under the provisions of 3.	.TION. 7 CFR 1.136(a). In no event, however, may a	
after SIX (6) MONTHS from the mailing date of this communic If the period for reply specified above is less than thirty (30) da If NO period for reply is specified above, the maximum statuto Failure to reply within the set or extended period for reply will, Any reply received by the Office later than three months after the earned patent term adjustment. See 37 CFR 1.704(b). Status	ays, a reply within the statutory minimum of th ry period will apply and will expire SIX (6) MO by statute, cause the application to become A	NTHS from the mailing date of this communication. ABANDONED (35 U.S.C. § 133).
1) Responsive to communication(s) filed	on 06 November 2001	
, ,	☐ This action is non-final.	
3) Since this application is in condition fo		atters prosecution as to the merits is
closed in accordance with the practice Disposition of Claims		
4) Claim(s) 1-25 is/are pending in the app	olication.	
4a) Of the above claim(s) is/are v	vithdrawn from consideration.	
5) Claim(s) is/are allowed.		
6) ☐ Claim(s) is/are rejected.		
7) Claim(s) is/are objected to.		
8) Claim(s) <u>1-25</u> are subject to restriction a	and/or election requirement.	
Application Papers		
9) The specification is objected to by the Ex	xaminer.	
10) The drawing(s) filed on is/are: a)	☐ accepted or b)☐ objected to by	the Examiner.
Applicant may not request that any objection		• • • • • • • • • • • • • • • • • • • •
11) ☐ The proposed drawing correction filed or	n is: a)□ approved b)□	disapproved by the Examiner.
If approved, corrected drawings are require	• •	
12)☐ The oath or declaration is objected to by	the Examiner.	
Priority under 35 U.S.C. §§ 119 and 120		
13) Acknowledgment is made of a claim for	foreign priority under 35 U.S.C.	§ 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:		
1. Certified copies of the priority doc	cuments have been received.	
2. Certified copies of the priority doc	cuments have been received in a	Application No
 Copies of the certified copies of the application from the Internation See the attached detailed Office action for 	onal Bureau (PCT Rule 17.2(a)).	*
14) Acknowledgment is made of a claim for d	· / ·	
a) ☐ The translation of the foreign languation of the foreign languat	age provisional application has t	peen received.
Attachment(s)	,,	
Notice of References Cited (PTO-892) Notice of Draftsperson's Patent Drawing Review (PTO-8) Information Disclosure Statement(s) (PTO-1449) Paper	948) 5) Notice of	Summary (PTO-413) Paper No(s) Informal Patent Application (PTO-152)
6. Patent and Trademark Office TO-326 (Rev. 04-01)	Office Action Summary	Part of Paper No. 3

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DETAILED ACTION

Election/Restriction

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 5, 9, 11, 13, 18, 20, 23, 25, drawn to a lithium secondary battery comprising a lithium layer and a metal fluoride layer, classified in class 429, subclass 231.95.
 - II. Claims 6-8, 10, 12, 15-17, 21,22, drawn to a lithium secondary cell comprising a lithium layer and a metal fluoride substance, classified in class 429, subclass 232.
 - III. Claims 14 and 19, drawn to a lithium secondary cell comprising a lithium layer, a metal fluoride layer, a hydrophobic layer and another metal fluoride layer, classified in class 429, subclass 246.
 - IV. Claim 24, drawn to a method for manufacturing a lithium secondary cell, classified in class 29, subclass 623.1.
- 2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because they are not disclosed as capable of use together and have different effects such that Invention I comprises a substrate, a lithium layer and a metal fluoride

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layer; Invention II comprises a substrate and a layer comprising lithium and a metal fluoride and Invention III comprises a substrate, a lithium layer, a metal fluoride layer, a hydrophobic layer and another metal fluoride layer.

- 3. Inventions I, II, III and IV are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as by cold rolling or chemical reactions.
- 4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
- 5. This application contains claims directed to the following patentably distinct species of the claimed invention: I) Not having an hydrophobic layer and II) having an hydrophobic layer.

 If pick Invention I, choose either I) claims 1-5, 20, 25 or II) claims 9, 11, 13, 18, 23 or if pick Invention II, choose either I) claims 6-8 or II) claims 10, 12, 15-17 and further pick the hydrophobic layer materials by picking either claims, 21 or 22.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was not made to request an oral election to the above restriction requirement because of the complexity of the restriction and election of species. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the

fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Laura Weiner whose telephone number is (703) 308-4396. The examiner

works a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Patrick Ryan, can be reached at (703) 308-2383. The fax phone number for non-after finals is

703-872-9310 and the fax phone number for after-finals is 703-872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 308-0661.

Laura S. Weiner

Primary Examiner

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May 12, 2003